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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,212	06/20/2003	William T. Rochford	82200APAL	5833

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EXAMINER	
SCHILLING, RICHARD L	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/600212	Rach Ford et al
	Examiner	Group Art Unit
	R L Schilling	1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☑ Responsive to communication(s) filed on 6-20-03.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1, 2, 4-9, 12-20, 26-29 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1, 2, 4-9, 12-20, 26-29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, ~~Paper No(s)~~. 6-20-03

☐ Interview Summary, PTO-413

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 12 depends on cancelled claim 10.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-8, 13-20 and 26-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35

U.S.C. 103(a) as obvious over Bourdelais et al. '282. Bourdelais et al. '282 (see particularly column 5, lines 28-37; column 10, lines 45-65; column 11, line 64 - column 12, line 60) disclose color photographic materials with dyes formed from color couplers and patterns of microdots, including colored microdots, coloring the image formed from the couplers. The pattern may be ink printed between the supports and dye image or over the imaged element. The support materials in Bourdelais et al. may also be of a non-neutral color, e.g. blue. If Bourdelais et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the ink printed microdot patterns of Bourdelais et al. in the photographic elements of Bourdelais et al. containing dye images formed from couplers as disclosed in Bourdelais et al. and used in their working Examples.

3. Claims 1, 2, 4-9, 13-20 and 26-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aylward et al. Aylward et al. (see particularly column 3, lines 21-60; column 6, lines 65-67; column 11, lines 57-67; column 12, lines 21-52; column 14, lines 15-26; column 16, lines 17-39; column 17, line 44 - column 18, line 42) disclose laminating a sheet with a pattern, e.g. binder, artistic pattern, fine line, over dye images formed from couplers and

photographic elements. The pattern may be applied with ink, e.g. pen or ink jet. Also, the supports of the photographic elements are preferably non-neutral blue. The photographic elements may also contain printed patterns of colored microdots. If Aylward et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to ink print patterns on sheets as disclosed in Aylward et al. for applying over dye images formed from color couplers and photographic elements as disclosed in Aylward et al. It would also be obvious to use the preferred blue tinted supports and/or printed patterns of colored microdots.

4. Claims 1, 4-8 and 13-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hannon and Wingender. Hannon (see particularly column 2, lines 3-60) discloses ID cards comprising photographs laminated with printed pattern polymer sheets. The composition of the photographs is not disclosed. However, since Wingender (see particularly column 1, lines 10-16) discloses that photographs commonly used in ID cards are color photographs formed from color couplers, it would be obvious to one skilled in the art to use color photographs formed from color couplers as the called for photographs in Hannon. Hannon also discloses printed areas adjacent the photograph of the person.

5. The prior art submitted by applicants and cited in the parent application has been considered.

6. Claims 1, 4-7, 15-19 and 26-29 are rejected under 35 U.S.C. § 102(b) as being fully met by Dean et al. Dean et al. (see particularly column 1, lines 18-43; column 2, lines 17-34; column 3, lines 3-72; column 4, lines 54-71; the Figure) disclose processes for coloring multicolor photographic dye images by laminating thereon sheets with dyed relief image pattern thereon or by dyeing relief images already on multicolor photographic dye image elements. In regard to claims 5-7, both base 10 and laminated sheet 14 in Dean et al. are supports or bases for the color image.

7. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-9, 12-20 and 26-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,693,042. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed elements in applicants' parent patent include photographic articles with dye images formed from color couplers overprinted with ink as specifically set forth in claim 3 of the U.S. patent.

8. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc
April 6, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP ~~1100~~ 1752